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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/422,537	10/21/1999	MARK C. DAVIS	RSW9-99-111	5674

7590 08/18/2004

JEANINE S RAY-YARLETTS
IBM CORP DEPT T81 BLDG 062
PO BOX 12195
RESEARCH TRIANGLE PARK, NC 27709

EXAMINER

TRAN, TONGOC

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 08/18/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/422,537

Applicant(s)

DAVIS ET AL.

Examiner

Tongoc Tran

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's amendment filed on 4/8/2004. Claims 1-3, 5-6, 9, 11-24, 26, 28-30, 32-33, 36, 38-51, 55-57, 59-60, 63, 65-78 and 80 have been amended. Claims 10, 37 and 64 have been cancelled. Claims 1-9, 11-36, 38-63 and 65-81 are pending.

Double Patenting

2. Claims 1, 28 and 55 of this application conflict with claims 1, 28 and 55 of Application No. 09/422,492, claims 1, 22 and 43 of Application No. 09/422,431 and claims 1, 22 and 43 of Application No. 09/422,430. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ocker*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1, 28 and 55 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 22 and 43 of copending Application No. 09/422,430. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Independent claims 1, 28 and 55 of the instant application and the co-pending application claim the same scope of invention even though the wordings are not all identical. The instant application recites "computer-readable program...enables a clerk process associated with a group that is a community member authorized to view that elements... when decrypting the encrypted elements" and the co-pending application recites "computer-readable program...enables each community member authorized to view that element ...when decrypting the encrypted element". Since the proxy client is acting on behalf of an individual user who is an authorized community member and the scope of the invention is the same. Therefore, they are directed to the same invention.

Claims 1, 28 and 55 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 28 and 55 of copending Application No. 09/422,492, and claims 1, 22 and 43 of copending Application No. 09/422,431. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant Application and other copending Applications all claim the same limitations except the step of enabling the different authorized group of users belonging to the community members or processes to decrypt the encrypted element that they are authorized to view. Even though the group clerk process of the instant Application and proxy client, recovery agent of the copending Applications represent the different group of users or processes, it would have been obvious that they are enabled to decrypt the encrypted document when they are one of the community members authorized to view the element.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Dependent claims 2-27, 29-54 and 56-81 are rejected because by their dependency they contain the language of the independent claims.

Conclusion


3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (703) 305-7690. The examiner can normally be reached on 8:30-5:00 M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Tongoc Tran
Art Unit: 2134

TT


August 10, 2004


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100